



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,630	08/19/1999	YOSHIHIRO SAITO	3045-1222	4583

21888 7590 09/24/2002

THOMPSON COBURN, LLP  
ONE FIRSTAR PLAZA  
SUITE 3500  
ST LOUIS, MO 63101

EXAMINER

AHMED, SAMIR ANWAR

ART UNIT PAPER NUMBER

2623

DATE MAILED: 09/24/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/367630

Applicant(s)

Satio et al.

Examiner

S. Ahmed

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/20/02
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-17, 19-24, 31-40, 42-49 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 11-17, 19-24, 31-40, 42-49 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- 1. ☐ Certified copies of the priority documents have been received.
  - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 2623

### RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 11-17, 19-24, 31, 34-35, 38-39, 42-49 are drawn to a locking device, and a switching device comprises a pressure-based fingerprint sensor and a portable key unit, classified in class 382, subclass 124.
  - II. Claims 32, 36 are drawn to a locking device, and a switching device comprises a pressure-based fingerprint sensor and a plurality of semiconductor memory devices and a plurality of processors being configured to determine in parallel a match between a detected fingerprint and a registered fingerprint, classified in class 235, subclass 382.
  - III. Claims 33, 37 are drawn to a locking device, and a switching device comprises a pressure-based fingerprint sensor and a processor configured to determine a match between a detected fingerprint and a registered fingerprint, the processor being further configured to make a negative fingerprint match determination, classified in class 340, subclass 5.83.
  - IV. Claim 40 is drawn to a lock and switch controlling system comprises a locking mechanism for locking and unlocking a first object, a starting switch in circuit with a second object, said starting switch being operable to connect or disconnect power to said second object, a pressure-based fingerprint sensor, classified in class 235, subclass 380.

Art Unit: 2623

2. The inventions are distinct, each from the other because of the following reasons:

Inventions in Group I, Group II, group III and Group IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the broadest combination claim i.e. claim 11 does not recite the elements found in the broadest subcombination claims i.e. claims 32, 33, 40. The subcombination inventions has separate utility such as in Group II, a locking device with a plurality of processors being configured to determine in parallel a match between a detected fingerprint and a registered fingerprint to render a match decision quickly, in Group III, a locking device with a processor being configured to make a negative fingerprint match determination to guard against fraud, and in Group IV, a lock and switch control system that controls plurality of objects based on a fingerprint match decision.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II, III, and IV, restriction for examination purposes as indicated is proper.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

Art Unit: 2623

application. Any amendment of inventor ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir Ahmed whose telephone number is (703) 305-9870. The examiner can normally be reached on M-F from 8:00 AM to 4:30 PM.

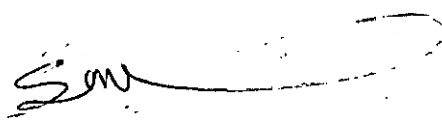
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au, can be reached on (703) 308-6604. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

SA

9/16/02

6/10/98



**SAMIR AHMED  
PRIMARY EXAMINER**